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RALPH E. JOCKE Walker & Jocke 231 SOUTH BROADWAY MEDINA, OH 44256			EXAMINER KHATTAR, RAJESH	
			ART UNIT	PAPER NUMBER
			3693	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/621,433

Applicant(s)

HANNA ET AL.

Examiner

RAJESH KHATTAR

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

The examiner for this application has changed. Please indicate Examiner Rajesh Khattar as the examiner of record in all future correspondence. This office action is in response to Applicant's communication filed on 2/1/2008. Amendment filed dated 10/5/2007 in which new claims 35-39 were added has been entered. Amendment filed dated 11/19/2007 in which new claims 40 and 41 were added has also been entered. As such, claims 1-41 are pending in the application.

As per Petition decision dated 5/19/2008, the final office action dated 11/2/2007 is vacated and the abandonment of this case is thus withdrawn. Examiner has introduced a new ground of rejection in this office action which causes this office action to be a new non-final.

Claim Objections

Claim 23 is objected to because of the following informalities: Examiner recommends changing "communication with" to "communication to" for clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, transmitting the input via an RF signal to the at least one input device is confusing. Examiner interprets this limitation to be transmitting the input via an RF signal to the at least one other input device.

In a similar manner, Examiner interprets the claim 23 to be transmitting the input via wireless communication to the at least one other input device.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2 and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 2 is directed to a method to transmit the input via a signal which is a non-statutory subject matter. As per MPEP § 2106.02, If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

Claim 7 is directed to a method of programming a RFID tag with the deposit data. A purely software claim that is not tied to any structure is not patent eligible subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 17, 20-22, 24-25 and 26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukatsu, US Patent No. 4,593,183. Fukatsu discloses a method comprising:

(a) receiving depositor input via remote communication through at least one input device in operative connection with a deposit accepting machine, wherein the input includes data associated with at least one deposit item (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20);

(b) depositing at least one deposit item into the deposit accepting machine (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 2, Fukatsu discloses (c) transmitting the input via an RF signal to the at least one input device (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 3, Fukatsu discloses wherein the at least one input device comprises a reader device, wherein the reader device is operative to read at least one radio frequency identification (RFID) tag, wherein (a) includes reading at least one RFID tag with the reader device (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8,

lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 4, Fukatsu discloses wherein the at least one RFID tag includes the data, wherein (a) includes receiving the data from the at least one RFID tag (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 5, Fukatsu discloses wherein (a) includes communicating with at least one radio frequency identification (RFID) device (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20, bag detectors 170, 171 and 172 represent identification device). Examiner notes that the use of a radio frequency identification device is clearly an aesthetic design change (see MPEP § 2144.04). The design change that relates to ornamentation only and have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

Regarding claim 6, Fukatsu discloses wherein at least one RFID device comprises an RFID tag, wherein at least one RFID tag comprises deposit data, wherein (a) includes communicating RFID tag deposit data (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20, bag detectors 170, 171 and 172 represents identification device).

Regarding claim 7, Fukatsu discloses wherein at least one RFID tag is programmable, and further comprising programming the at least one programmable RFID tag with deposit data (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20, bag detectors 170, 171 and 172 represents identification device).

Regarding claim 8, Fukatsu discloses (c) depositing at least one RFID tag having deposit data into the deposit accepting machine (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 9, Fukatsu discloses wherein in (b) the at least one deposit item includes the at least one RFID tag (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 10, Fukatsu discloses wherein in (b) the at least one deposit item includes a deposit bag, and wherein the deposit bag includes the at least one RFID tag (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 11, Fukatsu discloses wherein in (b) the at least one deposit item includes a deposit ticket, and wherein the deposit ticket includes the at least one RFID tag (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag

cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 12, Fukatsu discloses wherein in (b) the at least one deposit item includes at least one check, and wherein the at least one check includes the at least one RFID tag (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 13, Fukatsu discloses wherein in (b) the at least one deposit item includes a plurality of checks, and wherein each check includes at least one check RFID tag (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 17, Fukatsu discloses wherein RFID tag deposit data corresponds to at least one of a deposit bag ID, an account number, a depositor ID, and a deposit amount, wherein (a) includes communicating with at least one RFID tag comprising deposit data (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 20, Fukatsu discloses wherein the deposit accepting machine comprises an automated merchant banking apparatus, wherein (b) includes depositing at least one deposit item into the automated merchant banking apparatus (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained

without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 21, Fukatsu discloses wherein the deposit accepting machine comprises an ATM, wherein the ATM is operative to communicate with a bank host computer, wherein (b) includes depositing at least one deposit item into the ATM (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 22, Fukatsu discloses wherein the ATM is operative to dispense currency deposited in (b), and further comprising dispensing deposited currency from the ATM (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 24, Fukatsu discloses (c) preparing with the deposit accepting machine at least one receipt comprising an RFID tag (col. 1, lines 45-60).

Regarding claim 25, Fukatsu disclose wherein (b) includes outputting from the deposit accepting machine the at least one receipt comprising an RFID tag (col. 1, lines 45-60).

Claims 26-28 and 30-32 are substantially similar to claims 1-4, 9, 10 and 12 and hence rejected on similar grounds.

Regarding claim 29, Fukatsu discloses wherein the deposit data corresponds to at least one of a deposit bag ID, an account number, a depositor ID, and a deposit

amount (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 33, Fukatsu discloses wherein the at least one input device comprises at least one RFID reader device, and further comprising: (c) depositing at least one RFID tag into the deposit accepting machine, wherein the at least one RFID tag includes deposit data associated with the at least one deposit item in step (b), and wherein step (a) includes reading the deposit data from the at least one RFID tag with the at least one RFID reader device (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 34, Fukatsu discloses wherein the at least one RFID reader device is located inside the machine, and wherein steps (b) and (c) are carried out prior to step (a) (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Regarding claim 35, Fukatsu discloses wherein step (b) includes manually depositing the at least one deposit item into the deposit accepting machine (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Claims 36-37 and 39 are substantially similar to claims 1, 17 and 10 and hence rejected on similar grounds.

Regarding claim 40, Fukatsu discloses wherein the deposit accepting machine includes an access opening configured to enable manual insertion of at least one tangible deposit item into an interior area of the deposit accepting machine, wherein step (b) includes manually inserting at least one tangible deposit item through the access opening (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-16, 18-19, 23, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukatsu in view of Official Notice. Regarding claim 41, Fukatsu discloses wherein the deposit accepting machine includes an access opening configured to enable manual insertion of at least one tangible deposit item into an interior area of the deposit accepting machine (Fig. 2, col. 2, lines 40-65, col. 3, lines 5-20, Fig. 9, col. 8, lines 1-15, the bag cannot be obtained without selection of the deposited transaction, col. 8, lines 37-60, col. 15, lines 34-63, col. 16, lines 8-20). Fukatsu discloses the invention as described above. Fukatsu fails to specifically

disclose wherein each check RFID tag includes check data associated with at least one check indicia, wherein (a) includes receiving check data, wherein check indicia is at least one of an account number, a check number, an amount, a payee, and a payer, wherein (a) includes receiving check data associated with at least one of an account number, a check number, an amount, a payee, and a payer, wherein the check data is a value, wherein the value is a function of plural check indicia, wherein (a) includes receiving the value, wherein the RFID tag deposit data corresponds to a deposit amount, wherein the deposit amount includes the types of deposit items involved in the deposit and their respective amounts, wherein (a) includes receiving the deposit amount from the at least one RFID tag, wherein the RFID tag deposit data corresponds to a depositor ID, wherein the depositor ID includes a digital signature, wherein (a) includes receiving the depositor ID from the at least one RFID tag, transmitting the input via wireless communication with the at least one input device, wherein step (b) includes reading deposit data corresponding to a deposit amount and wherein the at least one input device is operative to receive via remote communication, depositor input data associated with the at least one tangible deposit item. However, Examiner takes Official Notice in this regard as these limitations are old and well known in the art.

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Fukatsu to include the disclosure of Official Notice. The motivation for combining these references would have been within the personal knowledge of a person having ordinary skills in the art.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJESH KHATTAR whose telephone number is (571)272-7981. The examiner can normally be reached on Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rajesh Khattar/
Examiner, Art Unit 3693